REMARKS

Initially, Applicants have amended claims 256 and 259 to more accurately claim the present invention and not for any reason related to patentability. No new matter has been added. Applicants believe that the following comments will convince the Examiner that the rejections set forth in the January 7, 2003 Office Action have been overcome and should be withdrawn.

I. THE INVENTION

Generally, the present invention is a system for accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a printed advertisement comprising at least one machine recognizable feature, which may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar code, magnetic code, printed character, invisible icon, etc. In the present invention, a machine recognizable feature is scanned or sensed, and converted into an electronic signal, which is transmitted for processing. In response to the electronic signal, programming material related to the information contained in the printed advertisement is displayed. Importantly, the present invention is designed to allow a user (e.g., a shopper) to

access programming material related to the printed advertisement.

II. THE EXAMINER'S REJECTIONS

A. DOUBLE PATENTING

The Examiner rejected claims 168, 256, and 259 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,932,863 (hereinafter referred to as "the '863 patent").

> "Although the scope of claims 168, 301 [256], and 304 [259] of the present application and claim 1 of the '863 patent are almost identical, the difference between the present claimed invention and the '863 patent is that the present claimed invention is a broader recitation of the '863 patent." (January 7, 2003 Office Action Summary, p. 3, paragraph 2).

B. 35 U.S.C. § 103

The Examiner rejected claims 168-173, 176-178, 195-196, 198, 212, 220, 227-230, 235-237, 240, 251, 256, and 258-261 under 35 U.S.C. § 103(a) as being unpatentable over Withnall *et al.* U.S. Patent No. 4,488,035 (hereinafter

referred to as "Withnall") in view of Fields U.S. Patent No. 4,481,412 (hereinafter referred to as "Fields") and Tannehill *et al*. U.S. Patent No. 5,158,310 (hereinafter referred to as "Tannehill"). The Examiner opined that Withnall discloses a system that includes a feature recognition device that reads at least one machine recognizable feature printed on a travel ticket to display travel information on the display of a portable handset. However, the Examiner admitted that:

> "Withnall et al fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming material in response to receiving the coded signal." (January 7, 2003 Office Action Summary, p. 5, paragraph 5).

The Examiner contended that Fields teaches these features by disclosing a microcontroller accessing means that includes a "barcode electronic circuit" coupled to a barcode reader, wherein the microcontroller accesses and transmits programming material in response to receiving a

coded signal. The Examiner argued that the system disclosed in Fields displays "video/image/programming/sound/pictorial/electronic/media data" on a "television/workbook."

The Examiner stated that combining the systems disclosed in Withnall and Fields would have been obvious at the time of Applicants' invention:

> "in order to provide Withnall et al with a higher technology system wherein the user being provided with a full complete information [sic] in a flexible ways [sic] ... Furthermore, such modification would have been an obvious extension as taught by Withnall et al." (January 7, 2003 Office Action Summary, p. 5, paragraph 5).

The Examiner then admitted that Withnall and Fields fail to teach a system comprising a printed advertisement having a machine recognizable feature including a "magnetic code/strip," which is claimed to be disclosed in Tannehill. The Examiner argued that the combination of Tannehill with Withnall and Fields would have been obvious:

> "to provide the consumer [with] a convenient way of saving money by displaying an advertising program, which attracting [sic] people to shop; business retailers therefore appreciated it [sic]

because they sell more, thus providing a more user-friendly system. Furthermore, such modification would provide Withnall et al/Fields with an alternative feature for encoding data (i.e., barcode or magnetic strip). Accordingly, such modification would have mere[ly] been a substitution of equivalents." (January 7, 2003 Office Action Summary, p. 6, paragraph 5).

Also, the Examiner rejected claims 174, 175, 180, 181, 183, 185, 189, 190, 192, 193, and 214-219 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Tannehill "as applied to claim 168" in view of Roberts U.S. Patent No. 5,324,922 (hereinafter referred to as "Roberts") and Malec *et al*. U.S. Patent No. 5,287,266 (hereinafter referred to as "Malec"). The Examiner admitted that Withnall, Fields, and Tannehill fail to teach online or home shopping and a cable television data link, and argued that these features are disclosed by Roberts. According to the Examiner, the combination of Roberts with Withnall, Fields, and Tannehill would have been obvious and would provide:

"a faster system due to the benefit of cable television transmitting capability. Furthermore, such modification would have been an obvious

extension as taught by Withnall et al/Fields/Tannehill et al to provide the user an alternative way of doing shopping." (January 7, 2003 Office Action Summary, p. 7, paragraph 6).

Moreover, the Examiner admitted that Withnall, Fields, Tannehill, and Roberts all fail to disclose an Integrated Service Digital Network ("ISDN") data link which, according to the Examiner, is disclosed by Malec. In the opinion of the Examiner, the combination of Malec with Withnall, Fields, Tannehill, and Roberts would have been obvious for providing:

"a more accurate and faster system due to the benefit of ISDN networking line[s]. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Tannehill et al/Roberts and would have mere[ly] been a substitution of equivalents." (January 7, 2003 Office Action Summary, p. 7, paragraph 6).

Next, the Examiner rejected claims 179, 182, 186-188, 191, 194, 199-201, 203-204, 209-210, 213, 221-226, 234, 239, 241-243, 254, and 257 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Tannehill "as applied to claim 168" in view of Bravman *et*

al. U.S. Patent No. 5,401,944 (hereinafter referred to as "Bravman"). The Examiner admitted that Withnall, Fields, and Tannehill fail to teach displaying information on a wireless communication device. According to the Examiner, Bravman teaches a remote unit providing travel-related information, and the combination of Withnall, Fields, Tannehill, and Bravman would have been obvious for providing:

> "a more flexibility [sic] system wherein the system is capable of providing the user all of his/her desired information about the trip/vacation that he/she is about to take, and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Tannehill et al." (January 7, 2003 Office Action Summary, p. 8, paragraph 7).

Also, the Examiner rejected claims 197, 202, and 205 under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Tannehill "as applied to claim 168" in view of Waterbury German Patent No. DT 24 52 202 A1 (hereinafter referred to as "Waterbury"). The Examiner admitted that Withnall, Fields, and Tannehill fail to teach an invisible machine recognizable feature, which is argued

to be taught by Waterbury. The Examiner asserted that the combination of Waterbury with Withnall, Fields, and Tannehill would be obvious for providing:

> "a more secure system wherein the data recorded in the machine recognizable feature is invisible to [the] naked eye, thus preventing manipulating [sic] by [a] fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Tannehill et al." (January 7, 2003 Office Action Summary, p. 9, paragraph 8).

Additionally, the Examiner rejected claims 206-208 and 211 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Tannehill "as applied to claim 168" in further view of Schach *et al.* U.S. Patent No. 5,397,156 (hereinafter referred to as "Schach") and Waterbury. The Examiner admitted that Withnall, Fields, and Tannehill fail to teach a watermark, which is argued to be taught by Schach. In the Examiner's opinion, the combination of Schach with "Withnall et al/Fields/Tannehill et al aesthetic purpose" would have been obvious. "[S]uch modification would have been an obvious extension as taught by Withnall et al/Fields/Tannehill et al." (January 7, 2003 Office Action Summary, p. 9, paragraph 9).

The Examiner then admitted that Withnall, Fields, and Schach fail to teach an invisible watermark, which is argued to be taught by Waterbury. The Examiner asserted that the combination of Withnall, Fields, Tannehill, Schach, and Waterbury would be obvious for providing:

> "a more secure system wherein the data recorded in the machine recognizable feature is invisible to [the] naked eye, thus preventing manipulating [sic] by [a] fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Tannehill et al/Schach et al." (January 7, 2003 Office Action Summary, p. 10, paragraph 9).

Also, the Examiner rejected claims 231-233, 238, 239, 244-250, 252, 253, 255, and 256 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Tannehill "as applied to claim 168" in view of Morales U.S. Patent No. 5,872,589 (hereinafter referred to as "Morales"). The Examiner admitted that Withnall, Fields, and Tannehill fail to teach a display unit comprising a "personal planner/phone/pager," which is argued to be taught by Morales. In the Examiner's opinion, combining Withnall, Fields, Tannehill, and Morales would be obvious to provide:

"the user with the flexibility of selecting his/her desired display unit that is fitting [sic] his/her needs, thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Tannehill et al." (January 7, 2003 Office Action Summary, p. 11, paragraph 10).

III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

A. DOUBLE PATENTING

The Examiner rejected claims 168, 256, and 259 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of the '863 patent. In response, Applicants are filing a Terminal Disclaimer herewith to overcome the Examiner's double patenting rejection.

B. 35 U.S.C. § 103

The Examiner rejected claims 168-173, 176-178, 195-196, 198, 212, 220, 227-230, 235-237, 240, 251, 256, and 258-261 under 35 U.S.C. § 103(a) as being unpatentable over Withnall, Fields, and Tannehill. Applicants respectfully disagree and submit that none of the aforementioned claims are obvious in view of Withnall, Fields, and Tannehill. In

order for a claimed invention to be obvious in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations (see *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438(Fed. Cir. 1991))(see also Manual of Patent Examining Procedure §§ 2143-2143.03).

Initially, Applicants submit that no suggestion or motivation to modify or combine Withnall, Fields, and Tannehill exists.

> "Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original).

The Examiner contended that it would be obvious to combine the teachings of Withnall, Fields, and Tannehill to arrive at the various embodiments of Applicants' invention. Yet, the Examiner has cited only purported benefits of this combination without pointing to what motivation is provided

by the references themselves. Applicants submit that no combination of these references would have been obvious to one of skill in the art at the time of Applicants' invention. Specifically, Withnall discloses a system for easing the examination of commuter tickets for validity. This purpose is far removed from the intent of the training system disclosed by Fields. The training system of Fields is used to provide a user with audio/visual output from a videodisc player coinciding with material presented in a training manual. Moreover, the ticket validation system of Withnall has no apparent relation to Tannehill's advertising system. Specifically, Tannehill discloses a shopping cart comprising a visual display for displaying advertisements to a shopper. The differing purposes of these three references have no overlap in use, and therefore, would not provide one skilled in the art with a motivation or suggestion to combine these references. Thus, an inventive step must be performed for one skilled in the art to arrive at the idea of combining any features of Withnall, Fields, or Tannehill in any combination.

Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a) rejection actually support an "obvious to try" argument. Of course, "obvious to try is not the standard for

obviousness under 35 U.S.C. § 103." Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, we respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. Cir. 1983):

> "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law."

Applicants submit that the only suggestion or motivation for the Examiner's combination of references is provided by the teachings of Applicants' disclosure. No such suggestion or motivation is provided by the references themselves; nor could there be in view of the difference in subject matter and the corresponding goals thereof.

In addition to the lack of suggestion or motivation to combine Withnall, Fields, and Tannehill, there is no expectation of success for the combination of these references, and any possible resulting device would not teach or suggest all of the limitations of the rejected

claims. Withnall discloses a machine capable of scanning a bar code on a commuter ticket and subsequently displaying the validity of the ticket based on information stored in a memory means. Fields discloses a system reading a bar code on a training manual for playing corresponding material from a videodisc. Tannehill discloses a shopping cart having a visual display for displaying advertisements. Applicants respectfully submit that that the combination of Withnall, Fields, and Tannehill cannot be successfully combined to disclose the dynamic programming material or the printed advertisement having a machine recognizable feature of the claimed invention. Importantly, claims 168, 256, and 259 all disclose the accessing of programming material resulting from recognition of a machine recognizable feature. The programming material of the present invention is designed such that it can be easily altered or updated at any time. As a result, a user will be provided with the most recently updated version of the associated information (or programming material) upon scanning an advertisement. This is not possible with the combination of Withnall, Fields, and Tannehill. Even if it were successful or proper to combine these three references (of coarse, Applicants believe the combination would not be successful or proper), the combination would provide a

system with static, not dynamic, audio/visual material. Specifically, if the audio/visual material were to come from the videodisc player of Fields, a videodisc player would be located on, for example, a bus. Therefore, anytime information must be updated, a new videodisc must be inserted into the videodisc player. This is not feasible, especially because the validity of a ticket can change each time a ticket is used and could require a new videodisc to be employed every time a ticket is used. In the case that the audio/visual material of Tannehill is used, it would be static, rather than dynamic, because the audio/visual material must be locally stored.

> "[O]ne or more memory devices, not shown, composing part of the electronic display circuitry could be periodically conveniently replaced, with the new memory device containing the new material to be outputted on the display." (col. 14, lines 40-44)(emphasis added).

Tannehill further states that "the display system 299 does not attempt to transmit information via airborne signals." (col. 17, lines 1-3). Thus, Tannehill specifically discloses a system where all matter for display is stored locally within the display circuitry, and therefore, cannot provide the dynamic programming material of the present

invention because updating the stored matter of Tannehill would require individually updating the memory means within each display of each shopping cart. Moreover, the radio data link of Withnall cannot be utilized to access a remote videodisc player or other such audio/visual material because the radio data link is designed only for transmitting a validity state and not substantially different audio/visual material. In particular, audio/visual material requires substantially more data to be transmitted in a specialized format. Thus, a system for achieving such transmission would need to be invented and implemented for remotely accessing such material.

Additionally, the printed advertisement having a machine recognizable feature as claimed is not disclosed within the combination. Tannehill discloses a displayed advertisement having a code thereon. This, however, differs significantly from the printed advertisement of the claimed invention. The code of Tannehill is designed to be read by the display apparatus for determining which advertisement is displayed. A shopper using Tannehill's system would not be able to scan the disclosed code because the feature is contained within the display apparatus. Also, the displayed material contains the code, and therefore, the code cannot be used to access the displayed

material itself. Therefore, any attempt to combine Withnall, Fields, and Tannehill to create the present invention would be unsuccessful and fail to provide the flexible, dynamic, updateable system of the claimed invention. Moreover, the dynamic programming material and the printed advertisements comprising a machine recognizable feature of the claimed invention are not disclosed by the combination of these references.

In view of the foregoing, base claims 168, 256, and 259 cannot be unpatentable over Withnall, Fields, and Tannehill. The remaining rejected claims are dependent on these claims and contain all of the limitations of their respective base claims. Therefore, these claims are also not unpatentable over these references.

In all subsequent rejections, the Examiner noted the deficiencies of the Withnall, Fields, and Tannehill combination regarding matter disclosed in dependent claims and appended various other references including Roberts, Malec, Bravman, Waterbury, Schach, and Morales to the combination in order to provide the additional features of the dependent claims. However, the combination of Withnall, Fields, and Tannehill has been shown to be not only improper, but also to lack the disclosure of each and every element of the base claims. Because this combination

is improper and incomplete, any further combining of references to Withnall, Fields, and Tannehill would also be improper. Thus, Applicants respectfully submit that all remaining rejections have also been overcome and should be withdrawn.

CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and favorable action is accordingly solicited.

Respectfully submitted,

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